

interpretation of any of the claims. Instead, such discussed differences merely help the Office appreciate important claim distinction discussed thereafter.

The disclosed invention is directed to solving a problem that a user of electronic mail may have encountered: receipt of unauthorized messages, such as through spamming. As explained in the background of the application, certain electronic mail systems allow the user to specify how to handle a received message. In those systems, the user specifies a characteristic of the message for detection, such as sender = John Smith, so that those systems can determine which messages satisfy the characteristic. However, those systems do not allow the user to specify how to automatically handle received messages if the user is unaware of certain characteristics of the message. For example, the user may not know in advance the identity of the sender of junk mail.

The Office has cited U.S. Patent No. 6,092,101 to Birrell *et al.* The Birrell system, like the systems described in the background of the application, allows the user to configure one or more filters, which is referenced as named filter queries 910. If the content of a new message does not match any of the named filter queries 910, then the Birrell *et al.* system would give the new message an inbox label and an unread label. Any other messages would receive only the unread label. The Birrell *et al.* system suffers from the same problems as those systems described in the background of the application. A user of Birrell's system would need to specify various characteristics using one or more named filter queries 910. If the user is unaware of certain characteristics of an unauthorized message, such as the name of the sender, the Birrell *et al.* system would incorrectly label the unauthorized message as requiring the user's attention by affixing both the inbox label and the unread label to it.

In contrast, a disclosed embodiment of the present invention determines whether a sender of a message is designated as being authorized and indicates to the user that the message is from an authorized sender. Birrell's approach, on the other hand, is to determine whether the content of the message is from an unauthorized source, but because Birrell's knowledge of unauthorized sources is imperfect, Birrell leaves the user as vulnerable to spamming as those systems described in the background of the application. The essence of the difference between the disclosed embodiment and the Birrell *et al.* system is that the disclosed embodiment is based on a list of senders from whom E-mails *should be* received whereas the Birrell system is based on just the opposite—i.e., a list of senders from whom E-mails *should not be* received.

The Office has also cited the Birrell *et al.* patent in combination with U.S. Patent No. 5,931,905 to Hashimoto *et al.* The Office has indicated that the Birrell system labels an unauthorized message as unread, and that alone, according to the Office, discloses storing the electronic mail message in a second folder designated for messages received from unauthorized senders. Applicants does not believe this is a correct characterization of the teaching of the Birrell *et al.* patent because Birrell *et al.* system simply labels a message as unread. After labeling a message, the Birrell system does not move the message to a folder dedicated to messages received from unauthorized senders. Given this defect, the proposed combination of Birrell *et al.* and Hashimoto *et al.* will not cure it. Moreover, Hashimoto *et al.* indicate that if the sender of the message is not registered in the authorized sender list, the message is abolished. This also renders the Hashimoto *et al.* patent insufficient to describe the disclosed invention because the disclosed invention would have an unauthorized message moved to a folder—not destroyed.

Having discussed the disclosed invention and the differences between the disclosed invention and the cited references, applicant now turns to the claim rejections of the Office Action in the following paragraphs.

Claim Rejections – 35 U.S.C. Sec. 112, second paragraph

The Office has rejected claims 25-28 under 35 U.S.C. sec. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office has indicated that these claims are identical to claims 1-4. While applicant does not entirely agree with the Office, applicant has conformed to the rejection by canceling claims 25-28. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. Sec. 102(e)

The Office has rejected claims 5-9 under 35 U.S.C. Sec. 102(e) as being anticipated by the Birrell *et al.* patent. Applicant respectfully submits that the Office has failed to state a *prima facie* case of anticipation. MPEP sec. 2131 requires that “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.”

The Office has failed to show and applicant is unable to find the subject matter of claims 5-9 in Birrell. For example, the Birrell *et al.* patent does not discuss the act of determining whether the sender of the message is designated as being authorized, as recited in claim 5. The Office has cited various portions of the Birrell patent, such as Figure 9, item 930; named filter queries 910; and column 11, lines 27-46. These portions teach just the opposite from what is specified in claim 5. Rather than teaching the act of determining whether the sender of the message is designated as being *authorized*, the Birrell *et al.* patent teaches determining whether the sender of the message is designated as being *unauthorized*.

Because the Office has failed to state a *prima facie* case of anticipation, the rejection should be withdrawn. Claim 5 is independent. Claims 6-9 are allowable because they depend on an allowable independent claim and because of the additional limitations added by those claims. Reconsideration and allowance of claims 5-9 is respectfully requested.

Claim Rejections – 35 U.S.C. Sec. 103

The Office has rejected claims 1-4, 11-14, 16, and 19-24 under 35 U.S.C. Sec. 103(a) as being unpatentable over the patent to Birrell *et al.* in view of U.S. Patent No. 5,931,905 to Hashimoto *et al.* The Office has also rejected claim 10 under 35 U.S.C. Sec. 103(a) as being unpatentable over the patent to Birrell *et al.* as applied to claim 9 and further in view of Microsoft Corporation, "Excerpts from Online Documentation of Microsoft Exchange," version 5.0.1458.47 (1986-1997) (hereinafter, Microsoft reference). The Office has also rejected claim 17 under 35 U.S.C. Sec. 103(a) as being unpatentable over the patent to Birrell *et al.* as applied to claim 5 and further in view of U.S. Patent No. 5,619,648 to Canale *et al.* (hereinafter, Canale).

The Office has failed to show, and applicant is unable to find, where Birrell and Hashimoto, or Birrell and the Microsoft reference, or Birrell and Canale, each alone and in combination, disclose the subject matter of the claimed invention. For example, applicant is unable to find where Birrell and Hashimoto discuss "when the sender of the electronic mail message is determined to be not authorized, the electronic mail message is stored in a second folder designated for electronic mail messages received from unauthorized senders" as recited in claim 1. Unlike the claimed invention, the Birrell *et al.* system only labels an unauthorized message as unread, and no more. Also, the Birrell *et al.* and the Hashimoto *et al.* systems cannot be combined to produce a workable system. The Birrell *et al.* system would label an

unauthorized message as unread, but the Hashimoto *et al.* system would destroy it. To combine these two systems, either the approach of Birrell *et al.* must be abandoned or the approach of Hashimoto *et al.* must be jettisoned, and the resultant combination would destroy the operation of the system described in either reference.

Because the Office has failed to state a *prima facie* case of obviousness, the rejection should be withdrawn. Claims 1, 5, and 20 are independent claims. Claims 2-4, 10-14, 16-17, 19, and 21-24 are allowable because they depend on allowable independent claims and because of the additional limitations added by those claims. Reconsideration and allowance of claims 1-4, 10-14, 16-17, and 19-24 is respectfully requested.

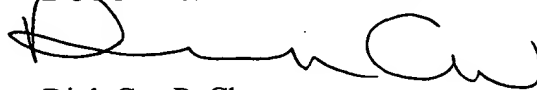
Information Disclosure Statement (hereinafter, IDS)

The Office has crossed out the listing for references AN-AS in the IDS, which was submitted to the Office on August 8, 2000. A copy of each reference was sent to the attention of the Examiner via facsimile communications on August 18, 2001. Applicant has submitted another Information Disclosure Statement listing again references AN-AS, and respectfully requests that the Examiner consider and initial each reference.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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Enclosures:

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